

### **DETAILED ACTION**

Receipt of Response to Election/Restriction filed on February 25 2008 is acknowledged. Claims 11-15 were amended. Claims 1-17 are pending.

#### ***Information Disclosure Statement***

The information disclosure statements (IDS) submitted on 9/10/04, 11/10/04, and 12/20/07 were considered by the examiner.

#### ***Election/Restrictions***

The requirement for election/restriction set forth in the Office action mailed on 1/23/08 is **withdrawn**. Accordingly, claims 1-17 are being examined on the merits herein.

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

**Claims 8-10, 15 and 17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

Claims 8-10 and 17 contain the phrase "ratio of". This phrase is confusing. It is unclear what the ratio is referring to as only one compound is listed in each of the claims. The examiner believes that "ratio" is actually referring to the amount of the

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product compound included in the invention and will interpret the claim this way for purposes of applying art.

Claim 15 as currently written is confusing. The claim indicates that 1 to 30% wt% of a saccharide "if it contains the said saccharide". First, it is unclear what actually is being referred to as "it". It appears what is attempting to be claimed that if the optional saccharide is included it is present in an amount from 1 to 30% and the examiner will interpret the claim this way for purposes of applying art..

#### **Claim Rejections - 35 USC § 103**

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Applicant Claims
2. Determining the scope and contents of the prior art.
3. Ascertaining the differences between the prior art and the claims at issue, and resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein

were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

**Claims 1-9, 11-13 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miyamae et al. (JP 2000-060363, cited in the Office action filed January 25 2008) in view of Soeda et al. (US Patent No. 6475542).**

#### **Applicant Claims**

Applicant claims a lure containing a protein crosslinked by a protein crosslinking enzyme, a non-water soluble polysaccharide and optionally at least one saccharide selected from a group consisting of monosaccharides, oligosaccharides, glutinous starch syrup, and dextrans. A specific protein claimed is gelatin. A specific crosslinking enzyme is transglutaminase. A specific polysaccharide claimed is cellulose and microcrystalline cellulose.

#### **Determination of the Scope and Content of the Prior Art (MPEP §2141.01)**

Miyamae et al. is directed to false food for fishing. The food comprises gelatin as the base (claim 1). The false food containing sweeteners such as sorbitol, starch syrup, granulated sugar and powdered sugar (claim 4). It is disclosed that flavors and smells that fish like are added such as spice, honey, amino acid and anise oil, and cuttle fish oil (paragraph 0014). A specific working example includes gelatin, sorbitol, starch syrup, granulated sugar. The process of making the compositions results in mixing of the

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ingredients with heat and the composition is poured into a mold that is modeled after live paid to obtain the false food for fishing (paragraph 0021).

**Ascertainment of the Difference Between Scope the Prior Art and the Claims  
(MPEP §2141.012)**

Miyamae et al. do not specify utilizing the false fish food for fishing. Miyamae et al. do not disclose cross-linking the gelatin or including cellulose. However, these deficiencies are cured by Soeda et al.

Soeda et al. is directed edible microcapsule and food. It is disclosed that crosslinking utilizing transglutaminase is remarkably superior for hardening or solidifying (column 2, lines 23-28). It is disclosed that methyl cellulose or carboxymethyl cellulose is added in the process of hardening by transglutaminase in order to prevent agglomeration or caking of the capsule. Exemplified is crosslinking gelatin with transglutaminase and the utilization of crystalline cellulose as an antiblocking agent. The amount of gelatin utilized in the examples are about 20% while the amount of polysaccharide is about 10%.

***Finding of Prima Facie Obviousness Rational and Motivation  
(MPEP §2142-2143)***

It would have been obvious to one of ordinary skill in the art to combine the teachings of Miyamae et al. and Soeda et al. and utilize transglutaminase and cellulose in the false fish food. One of ordinary skill in the art would have been motivated to utilize these components because transglutaminase is a known cross-linking agent of gelatin that proves for a superior hardened or solidified product as taught by Soeda et al. Cellulose as taught by Soeda et al. is utilized to prevent agglomeration or caking of

the capsule formed from the cross-linked gelatin. Therefore, one of ordinary skill in the art would have been motivated to cross-link the gelatin with transglutaminase and utilize cellulose as an antiblocking agent if a solid fish food was desired.

Regarding the claimed amounts of gelatin and polysaccharide, Soeda et al. discloses amounts that read on the instant claims. Furthermore, it would have been obvious to one of ordinary skill in the art to optimize the amounts utilized. It would have been obvious to one of ordinary skill in the art at the time of the invention to engage in routine experimentation to determine optimal or workable ranges that produce expected results. Where the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation. **In re Aller, 220 F. 2d 454, 105 USPQ 233 (CCPA 1955).**

It would have been obvious to one of ordinary skill in the art to utilize the false fish food in a method of fishing by placing the lure in a body of water containing fish. One ordinary skill in the art would have been motivated to utilize the product in this type of method because this is the intended use of the false fish food. As taught by Miyamae et al. the product is molded to resemble live bait, therefore one of ordinary skill would have been motivated to utilize the product in the same manner one utilizes live bait, such as fishing. Since the false fish food contains fish attractants as taught by Miyamae et al. it would have been obvious to utilize the food in a place where fish are mainly found, such as a body of water.

Absent any evidence to the contrary, and based upon the teachings of the prior art, there would have been a reasonable expectation of success in practicing the

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instantly claimed invention. Therefore, the invention as a whole would have been *prima facie* obvious to one of ordinary skill in the art at the time the invention was made.

**Claims 10, 15 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miyamae et al. in view of Soeda et al. and in further view of Nakatsuka et al. (US Patent No. 4076846).**

**Applicant Claims**

Applicant claims that the amount of saccharide is from 1 to 30 wt.%.

**Determination of the Scope and Content of the Prior Art  
(MPEP §2141.01)**

The teachings of Miyamae et al. are set forth above. Specifically, Miyamae et al. discloses a false fish food comprising gelatin, sorbitol, and saccharides.

**Ascertainment of the Difference Between Scope the Prior Art and the Claims  
(MPEP §2141.012)**

Miyamae et al. do not specify that the amount of saccharide is from 1 to 30 wt.%. However, this deficiency is cured by Nakatsuka et al.

Nakatsuka et al. is directed to edible molding compositions comprising a starch (abstract). The molding compositions are useful as foods, baits, etc. (column 11, lines 1-6). It is disclosed that can be utilized with bait paste for fishing to provide a sustained action bait (column 11, lines 48-54). Exemplified are molding composition comprising dextrin and gelatin (example 19). The amount of dextrin utilized is 5%.

**Finding of Prima Facie Obviousness Rational and Motivation  
(MPEP §2142-2143)**

It would have been obvious to one of ordinary skill in the art to combine the teachings of Miyamae et al., Soeda et al., and Nakatusuka et al. and utilize the saccharide in an amount of 5%. One of ordinary skill in the art would have been motivated to utilize this percentage as it is disclosed as a suitable percentage to utilize in baits for fishing. Furthermore, it would have been obvious to one of ordinary skill in the art optimize the amount of saccharide utilized. It would have been obvious to one of ordinary skill in the art at the time of the invention to engage in routine experimentation to determine optimal or workable ranges that produce expected results. Where the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation. **In re Aller, 220 F. 2d 454, 105 USPQ 233 (CCPA 1955).**

Absent any evidence to the contrary, and based upon the teachings of the prior art, there would have been a reasonable expectation of success in practicing the instantly claimed invention. Therefore, the invention as a whole would have been *prima facie* obvious to one of ordinary skill in the art at the time the invention was made.

### ***Conclusion***

No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ABIGAIL FISHER whose telephone number is (571)270-3502. The examiner can normally be reached on M-Th 9am-6pm EST.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter can be reached on 571-272-0646. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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